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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,563	06/02/2006	Michael Gavin Proctor	71,049-012	6206
27305 7590 11/25/2008 HOWARD & HOWARD ATTORNEYS, P.C. THE PINEHURST OFFICE CENTER, SUITE #101 39400 WOODWARD AVENUE BLOOMFIELD HILLS, MI 48304-5151				
EXAMINER				
MOORE, MARGARET G				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
11/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,563

Applicant(s)

PROCTOR ET AL.

Examiner

Margaret G. Moore

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 9, 11 to 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 9, 11 to 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1 to 9 and 11 to 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "less than or equal to about 5 parts by weight of the reinforcing fillers per 100 parts by weight of the one or more polymers (i) and the treated kaolin (ii)" is not supported by the specification and is considered to be new matter.

Applicants rely on the teachings in paragraph 20 as support for this new limitation but paragraph 20 refers to an amount rheology modifier and not a reinforcing filler. In fact, paragraph 20 teaches that the composition is preferably free of reinforcing fillers. Since (iv) in claim 1 includes rheology modifiers, this is obviously different from reinforcing fillers. Also since applicants stress in their remarks that reinforcing fillers have a specific definition, one cannot use the two term alternatively. This amendment is considered to be new matter.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. To clarify the claimed invention (as presently claimed), the Examiner notes that the treated kaolin must either be non-reinforcing or, if reinforcing, present only in the limited amount as claimed. This limitation necessarily follows from the claim language limiting the amount of reinforcing fillers.

4. The rejection in made in paragraph 3 of the previous office action has been withdrawn for reasons of record. Likewise the rejection over Woerner et al. in view of Joseph et al. has been withdrawn. Note that Joseph specifically refers to clay as a reinforcing filler and there is nothing to suggest using the treated clay of Joseph in Woerner in such a limited amount.

5. Claims 1 to 9 and 11 to 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woerner et al. in view of Cornelius et al.

This rejection relies on the rationale of record, as such this will not be repeated. Applicants' traversal is not persuasive.

Applicants argue that the '458 reference focuses on non reinforcing fillers while the focus of '141 is on reinforcing fillers. This is not an accurate summary of '141. Column 2, line 19 of '141 specifically refers to silica as a reinforcing filler. The Examiner does not see, and applicants have not cited, anything in '141 that would indicate that clay is used as a reinforcing filler. For instance, applicants argue on page 13 of their response that reinforcing fillers provide strength to the polymer. Cornelius teaches improved heat stability as a property associated to the treated clay. '141 refers to the benefits of adding a pretreated white clay to a silicone elastomeric composition and these benefits would have been similarly expected when pretreated clay is used as the non reinforcing filler of Woerner et al. In this manner the Examiner maintains the obviousness of the claims. In fact, since applicants have not established that the clay in '141 is a reinforcing filler, none of applicants' assertions (A) to (E) are persuasive. In addition, regarding (E), the Examiner notes that the obviousness is not based on substituting filler types but on selecting a particular silyl surface modified clay from the various fillers already taught in '458.

Reference to reinforcing fillers in '141 does not teach away from the obviousness of the combination or the claims since it is the silicone elastomer in '458 which meets the claimed requirement of (i), (iii) and the "substantially free of reinforcing fillers" limitation.

Applicants' assertions of unexpected results have not been supported with a clear and convincing, commensurate, showing of unexpected results. Since the composition in '458 overcomes the "expected" problems, this does not lend unobviousness to the claimed composition. In addition, if applicants are to argue that the treated kaolin functions as a reinforcing filler, then any results must include the kaolin in the limited amount as claimed. Applicants' cannot, on one hand, argue that the treated kaolin is a

reinforcing filler and, on the other hand, argue that the composition is substantially free of reinforcing fillers.

For new claim 12, please note that the surface treated clays in Cornelius having vinyl siloxyl groups are the same as that prepared as (ii). The fact that '141 prefers different alkoxy groups will not result in a different final surface treated kaolin.

Also, the Examiner notes that '458 does not specifically teach a mixture of two different siloxane gums but column 3, lines 15 to 20, teach siloxanes having an "x + y" value within the claimed range. Using a combination of different siloxanes would have been well within the skill of the ordinary artisan since 1) the use of the siloxanes individually is disclosed and it is prima facie obvious to combine two compositions, each of which is taught by prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose and 2) it would have been obvious and well within the skill of the ordinary artisan to combine different siloxanes in an effort to obtain a combination of different properties known to be associated therewith.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
11/21/08